

## REMARKS

Original claims 1-96 remain in the application. Claims 1, 18, 29, 30, 32-34, 45, 46, 74-77, and 83-85 have been examined.

Claims 1, 18, 29, 30, 32-34, 45, 46, 74-77, and 83-85 are provisionally rejected for obviousness-type double patenting over US Patent Application No. 09/679,039, US Patent Application No. 09/679,038, US Patent Application No. 09/728,693, US Patent Application No. 09/668,553, US Patent Application No. 09/668,331, US Patent Application No. 09/668,632, US Patent Application No. 09/668,515, US Patent Application No. 09/668,631, and US Patent Application No. 09/668,600. In view of the fact that prosecution is still ongoing in that application, the applicants reserve response to this provisional rejection until all other issues of patentability are settled in both applications.

The examiner rejects claims 1, 18, 29, 30, 32-34, 45, 74-77, and 83 for anticipation by US Patent 5,848,397 ("Marsh"). That rejection is respectfully traversed for the following reasons.

Taking claim 1 as representative, the rejected claims are directed to an "advertisement distribution system" for distributing advertisements to client devices via a communications network, which includes:

"at least one ad server that stores the advertisements to be distributed to the client devices, each advertisement being stored in a storage location designated by a source address;

at least one playlist server that receives a playlist request from each of the client devices, and that transmits a playlist response in response to each received playlist request; and

wherein the playlist response transmitted to each client device includes at least one playlist that identifies advertisements to be downloaded by that client device."

Marsh discloses message (ad) presentation functions that are distributed between a client computer and a server system. The complete disclosure of Marsh's system includes the subject matter of US Patent Application Serial No. 08/948,779 (now US Patent No. 6,014,502 of Moraes), incorporated by reference into Marsh at col. 2, lines 12-21. In Marsh's system, advertisements are selected by, obtained by, and downloaded from a mail server in a server system 104 that is "an electronic mail (e-mail) system which functions as an electronic post office." See Marsh at col. 6, lines 15-17.

The advertisements are downloaded by the e-mail server system to a client system in response to the client connecting to a mail server. See Moraes at col. 21, lines 3-6. According to Marsh at col. 16, lines 19-22, the advertisement download scheduler in the server system “controls the transfer of advertisements *from a Mail server  $M_n$*  to a client system 101.” (Applicants’ emphasis.) When the client system receives the downloaded ads, they are detected and stored by an advertisement display scheduler residing on a user computer. See Marsh at col. 3, lines 5-11. Neither reference discloses or suggests that advertisements are “downloaded by” a “client device”.

The contention in the Office Action is that Figure 8 of Marsh teaches “at least one ad server that stores the advertisements to be distributed to the client devices, each advertisement being stored in a storage location designated by a source address.” Figure 8 shows information communicated between a client system 101 and a server system 104 in which the server system 104 may receive advertisements from an advertiser 108. The advertiser 108 is not otherwise described in Marsh. The server system 104 is described as “an electronic mail (e-mail) system which functions as an electronic post office.” See Marsh at col. 6, lines 15-17. Marsh’s descriptions of Figure 8 and of the server system 104 omit any reference to “an ad server that stores the advertisements to be distributed to the client devices” in which the ads to be transferred are “stored in a storage location designated by a source address.” Marsh therefore omits “at least one ad server that stores the advertisements to be distributed to the client devices, each advertisement being stored in a storage location designated by a source address.”

The further contention in the Office Action is that Marsh describes “at least one playlist server that receives a playlist request from each of the client devices, and that transmits a playlist response in response to each received playlist request” in Figure 8 and at column 15, lines 10-20. Figure 8 shows an e-mail server system 104 in Figure 8. Neither the visible contents nor the description of Figure 8 teaches a “playlist server”, a “playlist request” from a client device, or a “playlist response” transmitted to a client device. Marsh at column 15, lines 10-20 describes advertisement display statistics and an event log file that are sent by a client system to the server system 104. However, this act is not described as a “request.” Nor does it have the attributes of a “request” in the sense of a message that signals initiation of an action or a protocol, which the “playlist request” clearly does. The teaching is that the statistics “can be used by the advertisement distribution scheduler and the advertisement download scheduler.” But

there is no teaching of how the file is used or that either scheduler acts in response to it. Both of these schedulers are components of the server system 104. They operate co-operatively to determine which advertisements are to be downloaded to (not "by") a client system. Neither scheduler "transmits a playlist response" to a client device that "includes at least one playlist that identifies advertisements to be downloaded by that client device."

Finally, the examiner contends that the "playlist response" is taught by Marsh at column 15, lines 1-10. In fact, in this passage, Marsh describes the statistics log file kept by the advertisement display scheduler 700 of the client system 101. According to Marsh's Figure 8, this file is transmitted by the client 101 to the server 104. Therefore, whatever the statistics log file is, it is manifestly not a "playlist response" or a response of any kind that is transmitted *to* a client *by* a server. Furthermore, there is no list of any kind in Marsh's system (including the statistics log file) transmitted by a server to a client device that "identifies advertisements to be downloaded by that client device" because client devices do not "download" advertisements. Marsh specifically limits that task to servers.

With respect to claims 18, 29, and 30, Marsh at column 8, lines 47-63 teaches digital representations of advertisements that are downloaded to a client device. These representations include control information (such as expiration date) and are used by the advertisement display scheduler 700 of the client device to schedule display of the advertisements by means of advertisement queues. Neither the digital representations, nor the queues identify advertisements "to be downloaded by that client device" and so are not playlists. Neither the digital representations nor the queues include "a list of corresponding source addresses that identify the corresponding storage location from which each respective advertisement can be fetched by that client device." Advertisements are not "downloaded by that client device" or by any client device in Marsh's message display scheduling apparatus. That task is explicitly reserved to an e-mail server system 104.

With respect to claims 32-34, 45, 74-76, and 83, "at least one playlist server receives the playlist request from each of the client devices at prescribed playlist check intervals." However, Marsh at column 3, lines 28-37 describes an advertisement download scheduler that determines when advertisements are to be downloaded to a client device. The only timing considerations described for this scheduler are priority (showcase versus banner advertisements) and the number of advertisements

transferred at any one time. No “interval” for receiving a client device request is described.

With respect to claim 77, “the prescribed playlist check intervals span a plurality of on-line e-mail sessions during which the respective client device is online for the purpose of sending and/or receiving e-mail messages.” No mention is made in Marsh at column 7, line 1 through column 8, line 11 of any client request received by a server for a playlist at prescribed intervals of any kind.

Accordingly, Marsh omits at least the elements discussed above and does not anticipate claims 1, 18, 29, 30, 32-34, 45, 74-77, and 83. If the examiner contends that these omitted elements are inherent, the examiner must introduce extrinsic evidence to establish that these elements are necessarily in the message presentation scheduling apparatus described by Marsh, or withdraw the rejection.

Claims 46, 84, and 85 are rejected for obviousness over Marsh. That rejection is respectfully traversed for the following reasons.

With respect to claim 46, the recitation is that “the client information portion of the playlist response transmitted to each client device includes a merge/not merge data field that has a first state and a second state, whereby that client device merges its new playlist(s) with its current playlist(s) in response to the first state of the merge/not merge data field, and does not merge its new playlist(s) with its current playlist(s) in response to the second state of the merge/not merge data field.” Marsh’s description has been diligently read without finding a list of any kind having a “data field” that causes or prevents the merger of the list with a later list of the same kind. Accordingly, Marsh lacks the recited element. Nevertheless, the examiner states “Marsh teaches displaying the playlist in different fashion” without identifying “the playlist” or the “fashion” by which it is displayed by any reference to an illustration or a figure of Marsh. The applicants respectfully request the examiner’s assistance in finding “the playlist” and the “fashion” of its display in Marsh. Furthermore, the characteristic of “the playlist” that is explicitly recited in claim 18 (from which this claim depends) is the list of ad identifiers that identify respective ones of the advertisements to be downloaded by that client device. The identification of advertisements to be downloaded has nothing to do with “displaying” the advertisements or with any “operating mode” of an advertisement.

With respect to claims 84 and 85, a playlist response is limited to having “a block ad display sequence data field that specifies whether that client device should select advertisements identified in the new playlist(s) for display in a linear or random


manner." Marsh lacks any "data field" in a "response" sent by a server to a client that specifies the order in which advertisements are to be displayed. Furthermore, Marsh specifies that the sequence of advertisement display is the function of the advertisement display scheduler 700. Specifically, Marsh says that the advertisement display scheduler "controls the display of both the banner advertisements 601 and the showcase advertisements 1001." See Marsh at column 8, line 34-38. Marsh goes on at great length to explain how this is done by means of advertisement queues in response only to specification of expiration date, maximum number of displays, and priority. It would seem that a command from a server in a playlist response to randomly display the advertisements downloaded to a client device would altogether usurp and nullify the function of Marsh's advertisement display scheduler. Therefore, Marsh contains no suggestion in this regard.

Therefore, in view of the failure of Marsh to fairly teach or suggest the invention recited in claims 46, 84, and 85, it is submitted that these claims recite subject matter that is unobvious over Marsh.

Accordingly, it is submitted that all of the originally-filed claims define subject matter that is patentably distinct from Marsh and the other references of record in this application, early notice of which is earnestly requested.

Respectfully submitted,

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